

Serial No.: 10/065,324
Confirmation No.: 9313
Applicant: HOLGERSSON
Atty. Ref.: 03485.0004.NPUS00

REMARKS

In response to the Office Action dated December 17, 2003, the Applicant respectfully requests reconsideration based on the following remarks. The Applicant respectfully submits that the claims as presented are in condition for allowance.

The United States Patent and Trademark Office (the "Office") restricted this application to claims 4-18. The Office has since rejected claim 18 under 35 U.S.C. § 112, paragraph two, as being indefinite. The Office also rejected claims 4-18 under 35 U.S.C. §102 (b) as being anticipated by U.S. Patent 5,230,457 to Hiroi *et al.* The Applicant shows, however, that the pending claims are patentably distinguishable over *Hiroi*, and the Applicant thus respectfully submits that the pending claims are ready for allowance.

Rejection Under § 102 (b)

The Office rejected claims 4-18 under 35 U.S.C. §102 (b) as being anticipated by U.S. Patent 5,230,457 to Hiroi *et al.* In response, the Applicant requests that the Examiner reconsider and withdraw the rejection in view of the following remarks.

A claim is anticipated only if "each and every element" of the claimed invention is found either expressly or inherently described in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571, 230 U.S.P.Q. (BNA) 81, 84 (Fed. Cir. 1986) ("absence from the reference of any claimed element negates anticipation."); *In re Schreiber*, 128 F.3d 1473, 1477, 44 U.S.P.Q.2d (BNA) 1429, 1431 (Fed. Cir. 1997). As pointed out by the court, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d (BNA) 1913, 1920 (Fed. Cir. 1989). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter

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existed and that its existence was recognized by persons of ordinary skill in the field of the invention. *See ATD Crop. V. Lydall, Inc.*, 159 F.3d 534, 545, 48 U.S.P.Q. 2d (BNA) 1321, 1328 (Fed. Cir. 1998). *See also In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q. 2d (BNA) 1655, 1657 (Fed. Cir. 1990). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter “M.P.E.P.”). As the Applicant shows, however, independent claim 4, and thus the dependent claims thereunder, are patentably distinguishable over *Hiroi*. The reference to *Hiroi* does not anticipate this invention, so the Applicant respectfully requests that Examiner Weeks remove the 35 U.S.C. § 102 (b) rejection of claims 4-18.

1. *Hiroi* Does NOT Control Position of the Stapler Based on “Sensed Position Information”

Hiroi does not anticipate independent claim 4. Claim 4 requires “controlling positional changes of the staple driver *based on the analysis of sensed position information*” (emphasis added). *Hiroi*, in contradistinction to this invention, analyzes current magnitudes when controlling the position of the stapler. If the current amperage is above a certain threshold, a “jam” is assumed and the motor is reversed. If the current amperage is low, a “blank shot” condition is assumed. As *Hiroi* explains, a current sensor is used to infer staple loads (*see* column 3, lines 66-69). If the current is within a “normal” range, the stapling operation is “deemed normal” (*Hiroi* at column 5, lines 3-5). If the current is higher than expected, it is assumed that a jam or other malfunction has occurred (*Hiroi* at column 5, lines 5-7). If the current is lower than expected, it is assumed that a “blank shot” has occurred (*Hiroi* at column 5, lines 7-9). A terminal of the controller “receives a detection signal from the current sensor” (*Hiroi* at column 5, lines 42-43). “The control circuit monitors the signal from the current sensor, that is, the current *I* through the motor” (*Hiroi* at column 5, lines 49-51). If the peak current is normal, “the home position of the stapler is confirmed, and the motor is stopped” (*Hiroi* at column 6, lines 1-7). If, however, “the current level is excessively high,” the motor is reversed (*Hiroi* at column 6, lines 8-13).

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Hiroi, then, does not anticipate independent claim 4. Claim 4 requires “controlling positional changes of the staple driver *based on the analysis of sensed position information*” (emphasis added). *Hiroi*, again in contradistinction to this invention, only analyzes current magnitudes controlling the position of the stapler. *Hiroi*, then, does not control position of the stapler based on analysis of “sensed position information.” Because *Hiroi* measures current through the motor, *Hiroi* cannot anticipate this invention. The Applicant respectfully requests that Examiner Weeks remove the 35 U.S.C. § 102 (b) rejection of independent claim 4.

The dependent claims are also not anticipated. Because *Hiroi* does not anticipate independent claim 4, the dependent claims 5-18 are likewise unanticipated. The Applicant, then, respectfully asks Examiner Weeks to remove the 35 U.S.C. § 102 (b) rejection of claims 4-18.

For the above reasons the Applicant submits that nowhere in the *Hiroi* reference is there believed to be any disclosure or suggestion to modify the structure shown in a manner to achieve the claimed invention. In view of the above, the Applicant requests the reconsideration and withdrawal of the rejection of claims 4-18 under 35 U.S.C. § 102 (b). The Applicant also asks that the Examiner indicate the allowance of the claims in the next paper from the Office.

The new claims have been added to alternatively claim the presently elected invention. The features recited therein regarding sensing stapler drive shaft speed and degree of rotation are asserted as being patentable over any singular, or appropriate combination of the references of record.

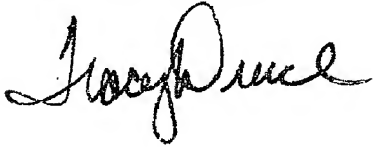
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The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 08-3038, referencing Order No. 03485.0004.NPUS00.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner should directly contact the undersigned by phone to further the discussion.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Tracy Druce", written in a cursive style.

Tracy W. Druce
Patent Attorney
Reg. No. 35,493